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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,698	05/14/2001	John M. Kirwan	F0397/7050	3328

7590

12/02/2004

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EXAMINER

MAIORINO, ROZ

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,698

Applicant(s)

KIRWAN ET AL.

Examiner

Roz Maiorino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: in claim 16 applicant claim a "propulsion means for fluid" however no where in the specification is there a description of a propulsion means description.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Regarding claim 16, the word "means" is preceded by the word(s) "propulsion" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1,3, 5-8, 15—12, 14--57 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S Patent No.6010495 to Tilton.

Tilton teaches a surgical device comprising of a cannula an applicator with an open tube, and a snap-fit ball and socket joint (figure 10-11), limited orifice , with a third unit, with all the units irremovably attached to each other.(figure 1)

4. Claims 1, 3 , 9-11,15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S Patent No.6146373 to Cragg et al.

Cragg teaches a surgical device with a cannula 48, an applicator 46, and an adaptor 38. The catheter injects a liquid forming a solidification agent.

5. Claims 1, 15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S Patent No.6248092 to Miraki et al.

Miraki teaches a device with a cannula 20 and an applicator 12, the device can be sterilized via autoclave. (Col.3, lines 50-55)

6. Claims 1, 12-13, 47-48 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S Patent No.5817072 to Lampropoulos et al.

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Lampropoulos teaches a surgical device with a cannula section 24 and an applicator section 14, where the cannula has a radio-opaque marker 280 molded in the one of the modules. (Col.16, lines 55-60) method of conducting the device comprises accessing a treatment site with a first device 10, through a cannula 12 wherein the first device is a single component device, and device can deliver therapeutic agent via lumen 38 to the treatment site via the first device, then a tube 14 is added to the device altering the first device to the second device and the second device can also deliver therapeutic agent to the site via lumen 38. (Col.6, lines 15-20, Col.7, lines 1-10)

7. Claims 1, 3, 5-12 14-58 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent NO. 5693031 to Ryan et al.

Ryan teaches a teaches a surgical device with a cannula section 16 and an applicator section 20 and an adaptor 368 where at least one of the unit are attached to each other via a articulating join.

8. Claims 1, 3, 5-12 14-58 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent NO. 5868817 to Moenning .

Moenning teaches a teaches a surgical device with a cannula section 16 and an applicator section 20/12 and an adaptor 14 where at least one of the unit are attached to each other via a articulating join 32.

Response to Arguments

9. Applicant's arguments with respect to claims 1-57 have been considered but are moot in view of the new ground(s) of rejection.

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10. Applicant's arguments filed 8/18/2004 have been fully considered but they are not persuasive.

a. Applicant alleges Tilton does not teach an adaptor section however as mentioned in the before adaptor in Tilton is item 100. further more it also teaches an artiuclaint joint in figures 10-11.

b. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the applicator being abled to have fluid go though it) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Although the applicant has NOT claimed and applicator in which fluid would be capable of passing through Cragg's applicator 38 is capable of allowing fluid to pass through it.

c. Applicant alleges Miraki does not teach an applicator and it teaches fluid delivery. However Miraki does teach an applicator 104a, and the fluid delivery is functional language since the applicant has claimed it by using functional language such as "suitable" hence Miraki only has to be capable of fluid delivery. And Miraki's apparatus is capable of fluid delivery.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Maiorino whose telephone number is 571- 272-4960. The examiner can normally be reached on 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 703-308-2698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RM



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